

**REMARKS**

Claims 1-8, 14 and 15 are pending in this application. By this Amendment, claims 1 and 14 are amended, and claim 15 is added. Support for the amendment to claims 1 and 14 may be found for example, in the original claims, specifications and drawings. No new matter is added. In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

**I. Rejection under 35 U.S.C. §112**

The Office Action rejects claims 1-8 and 14 under 35 U.S.C. §112, first paragraph for allegedly being non-enabling, and 35 U.S.C. §112, second paragraph, as allegedly being indefinite. The rejections are respectfully traversed.

**A. Rejection under 35 U.S.C. §112, first paragraph**

The Office Action states that the specification does not reasonably enable one of skill in the art to practice claims 1-8 and 14. However, the Office Action admits on page 2, "the specification...[is] enabling for: a) the work being applied with the coating as claimed in claims 6-8; and b) discharging liquid droplets as claimed in claim 5; and c) the shape as claimed in newly added claim 14" (original emphasis). Accordingly, as the specification describes particular embodiments for practicing the invention, and one of skill in the art would know based on the present disclosure to select and apply suitable works, coating, shape and coating method in order to practice the invention, the specification clearly enables one of ordinary skill in the art to practice the invention recited in claims 1-8 and 14. Therefore, reconsideration and withdrawal of the rejection of claims 1-8 and 14 is respectfully requested.

**B. Rejection under 35 U.S.C. §112, second paragraph**

The Office Action variously rejects claims 1 and 14 because 1) the recitation of a "film forming method" in claim 1 is allegedly indefinite, because the claims do not recite when the film is formed, 2) the recitation in claims 1 and 14 of "a functional liquid receiver"

is indefinite because the metes and bounds have not been defined as to when a receiver is "functional" and "non-functional," 3) the recitation in claim 1 of "shape" is indefinite because it has no metes and bounds, and 4) the recitation in claim 1 of "preliminary" is confusing.

Applicants respectfully traverse the rejection.

**1. "film forming method"**

Claim 1 recites a "film forming method," followed by the claim limitations describing the steps necessary to form the film. Accordingly, the film forms when all of the steps described in the claim are carried out. Therefore, because the recitation of a "film forming method" in claim 1 is sufficiently definite, reconsideration and withdrawal of the rejection against claim 1 and the claims dependent therefrom, are respectfully requested.

**2. "functional"**

Claims 1 and 14 have are amended to recite, in part, "a receiver for receiving functional liquid." Therefore, reconsideration and withdrawal of the rejection of claims 1 and 14, and the claims dependent therefrom, are respectfully requested.

**3. "shape"**

Claim 1 is amended to recite, in part, "a receiver for receiving functional liquid, wherein the receiver is formed in a ring shape corresponding to the flat shape of the work." Therefore, reconsideration and withdrawal of the rejection of claim 1, and the claims dependent therefrom, are respectfully requested.

**4. "preliminary"**

The Office Action states that the recitation in claim 1 of "preliminary" is confusing. However, paragraph [0008] of the present specification describes that the two steps of the film forming method according to the present invention are: 1) a preliminary discharge step of preliminarily discharging liquid droplets from heads, also known as a "flushing" step, and 2) a liquid droplet discharge step of discharging the liquid droplets onto the surface of the work.

The first step is recited in the claims as "*preliminarily* discharging liquid droplets" (emphasis added) or "the *preliminary* discharge of the liquid droplets" (emphasis added). The second step is recited in the claims as "discharging liquid droplets," "discharge the liquid droplets" or "the liquid droplet discharge step." Therefore, the specification clearly indicates the two different steps of discharging liquid, and the recitation in claim 1 of "preliminary" is not confusing in the context of the specification. Thus, reconsideration and withdrawal of the rejection of claim 1, and the claims dependent therefrom, are respectfully requested.

## **II. Rejection under 35 U.S.C. §103**

The Office Action rejects claims 1-3, 5, 7 and 8 over Japanese Patent Application No. 2001-180007 to Suzuki et al. ("Suzuki"), in view of U.S. Patent No. 6,660,332 to Kawase et al. ("Kawase") and further in view of Japanese Patent Application No. 2002-067346 to Hiroshi et al. ("Hiroshi"); rejects claim 4 over Suzuki in view of Kawase and further in view of Hiroshi and U.S. Patent No. 6,508,528 to Fujii et al. ("Fujii"); and rejects claim 6 over Kawase in view of Suzuki and further in view of Hiroshi and U.S. Patent No. 6,084,650 to Sekiguchi ("Sekiguchi"). These rejections are respectfully traversed.

Independent claim 1 has been amended, and recites in part, "preliminarily discharging liquid droplets from heads into a receiver for receiving functional liquid...wherein the receiver for receiving functional liquid is detached from the work" However, none of Suzuki, Kawase and Hiroshi, alone or in combination, teach or suggest at least this feature of claim 1.

Suzuki and Kawase are both silent as to preliminarily discharging liquid droplets into a receiver for receiving functional liquid, wherein the receiver is detached from the work. In fact, the Office Action admits, on page 5, that, "Suzuki does not disclose the preliminary discharge of the liquid droplets being carried out in a liquid droplet reception area." Moreover, Hiroshi describes, in paragraph [0120], abandonment fields 70a-70c (allegedly corresponding to the receiver for receiving a functional liquid according to the present

claims). However, such abandonment fields are formed *in* the recording medium, and is therefore attached to the recording medium.

By contrast, Figures 3, 5 and 6 of the present specification shows a functional liquid receiver that is detached from the work. Therefore, because none of Suzuki, Kawase and Hiroshi, alone or in combination, teach or suggest at least this feature of independent claim 1, reconsideration and withdrawal of the rejection of claim 1, and the claims dependent therefrom, are respectfully requested.

### **III. Double Patenting**

The Office Action provisionally rejects claims 1-4 as being unpatentable over claims 4-8 of co-pending Application No. 11/588,240 on the grounds of non-statutory obviousness-type double patenting. The provisional rejection is respectfully traversed.

No action by Applicants is required at this point. MPEP §822.01 provides that if the "provisional" double patenting rejection in one application is the only rejection remaining in the application, as is the case here for the reasons set forth herein, the Examiner should then withdraw that rejection and permit the application to issue as a patent.

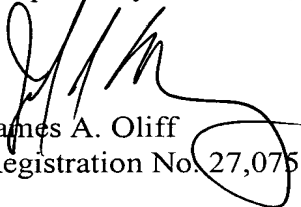
Accordingly, reconsideration and withdrawal of the non-statutory obviousness-type double patenting rejection upon the allowance of the subject matter of the pending claims are respectfully requested.

### **IV. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of this application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

  
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